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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,922	04/26/2001	Yingju Sun		2074

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
2645	2

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,922

Applicant(s)

SUN ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-15 are pending in this office action.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 26, 2001 have been accepted.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Regarding claim 1, the phrase " make/receive " renders the claim indefinite because it is not clearly defined.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6, 8, 10, and 11-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent Application Publication No. US 2003/0087665 by Tokkonen.

Regarding claim 1, Tokkonen discloses a mobile apparatus comprising (see Figure 1): a mobile device with telephonic capabilities so that a user of the mobile apparatus can, inherently, make/receive a call while in motion (page 1, column 1, section 0003, lines 1-4), the mobile

device including a user interface (as shown in Figure 1); a recording mechanism integrated within the mobile device and controllable through the user interface (page 2, column 1, section 0014, lines 1-4); and wherein the recording mechanism records an audio input from a user so that the audio input can be replayed later (page 2, column 1, section 0014, lines 20-23).

Regarding claim 2, the mobile apparatus of claim 1 mentioned above, wherein Tokkonen further discloses the mobile device includes a processor and a digital memory space (page 1, column 2, section 0011, lines 3-5); and wherein the recording mechanism operates under the processor and digitizes the audio input into an audio file that is stored in the digital memory space (page 2, column 1, section 0012, lines 1-4; page 2, column 1, section 0014, lines 20-23).

Regarding claim 3, the mobile apparatus of claim 2 mentioned above, wherein Tokkonen further discloses the digital memory space is either non-removable memory or removable memory (page 1, column 2, section 0011, lines 9-10).

Regarding claim 4, the mobile apparatus of claim 2 mentioned above, wherein Tokkonen further discloses the digital memory space may be audio grade dynamic RAM (page 1, column 2, section 0011, lines 9-10).

Regarding claim 5, the mobile apparatus of claim 1 mentioned above, wherein Tokkonen further discloses the recording mechanism only records the audio input from the user when the mobile device is off line or in the reminder function mode (page 2, column 1, section 0014, lines 1-4).

Regarding claim 6, the mobile apparatus of claim 1 mentioned above, wherein Tokkonen further discloses the mobile device includes a digital memory space, a microphone and a speaker (page 1, column 2, section 0011, lines 3-6); and wherein the recording mechanism is used as an

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audio recorder to record the audio input received from the microphone, to store the recorded audio input in the digital memory space when the mobile device is off line or in reminder function mode (page 2, column 1, section 0014, lines 1-4; page 2, column 1, section 0014, lines 20-23).

Regarding claim 8, the mobile apparatus of claim 1 mentioned above, wherein Tokkonen further discloses the user interface includes a set of keys and a display (page 1, column 2, section 0011, lines 3-6), the display displaying options for the user to place the mobile apparatus in a desired operation mode (page 2, column 1, section 0014, lines 1-4).

Regarding claim 10, the mobile apparatus of claim 1 mentioned above, wherein Tokkonen further discloses the mobile device is capable of data communication with another computing device; and wherein the audio input is processed in the mobile device and the processed audio input can be transferred to the another computing device (page 2, column 1, section 0013, lines 9-19).

Regarding claim 11, Tokkonen discloses a mobile apparatus comprising (see Figure 1): a wireless telephone including a processor, a digital memory space, a microphone and a speaker (page 1, column 2, section 0011, lines 3-6); and operating under the processor, the audio recording mechanism recording an audio input received from the microphone (page 2, column 1, section 0014, lines 20-21) when the wireless telephone is, inherently, not in telephonic operations (page 2, column 1, section 0014, lines 1-6).

Regarding claim 12, the mobile apparatus of claim 11 mentioned above, wherein Tokkonen further discloses the audio input is digitized and the digitized audio input is stored in the digital memory space (page 2, column 1, section 0014, lines 21-23).

Regarding claim 13, the mobile apparatus of claim 12 mentioned above, wherein Tokkonen further discloses the digitized audio input stored in the digital memory space can be replayed and listened to (page 2, column 1, section 0014, lines 21-23).

7. Claims 14-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,341,218 by Poplawsky et al.

Regarding claim 14, Poplawsky et al disclose a method for using a mobile apparatus (see Figure 2), the method comprising: providing the mobile apparatus, wherein the mobile device includes: a wireless telephone, inherently, having a microphone and a speaker (column 3, lines 12-16; column 4, lines 21-31); and an audio recording mechanism integrated within the wireless telephone; using the audio recording mechanism to record an audio input while, inherently, not using the wireless telephone (column 4, lines 32-47); and, inherently, playing back the recorded audio input from the audio recording mechanism through a speaker of the wireless telephone (column 4, lines 56-62).

Regarding claim 15, the method of claim 14 mentioned above, wherein Poplawsky et al further disclose forwarding the recorded audio input to a different device; and, inherently, playing back the recorded audio input from the different device (column 4, lines 48-53).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2003/0087665 by Tokkonen as applied to claim 6 above, and further in view of U.S. Patent No. 6,341,218 by Poplawsky et al.

Regarding claim 7, the mobile apparatus of claim 6 mentioned above, wherein Tokkonen further discloses the recorded audio input is replayed and listened to through the digital recorder (page 2, column 1, section 0014, lines 20-22; Figure 1, 20).

Tokkonen fails to teach the recorded audio input is replayed and listened to through the speaker.

Poplawsky et al disclose a method for using a mobile apparatus (see Figure 2), the method comprising: providing the mobile apparatus, wherein the mobile device includes: a wireless telephone, inherently, having a microphone and a speaker (column 3, lines 12-16; column 4, lines 21-31); and an audio recording mechanism integrated within the wireless telephone; using the audio recording mechanism to record an audio input while, inherently, not using the wireless telephone (column 4, lines 32-47); and, inherently, playing back the recorded audio input from the audio recording mechanism through a speaker of the wireless telephone (column 4, lines 56-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Tokkonen to have the recorded audio input replayed and listened to through the speaker as taught by Poplawsky et al in order for the user to listen to the recorded audio input. One of ordinary skill in the art would have been lead to make such a modification since the speaker is utilized to play back recorded audio input from the apparatus to the user and the digital recorder does not have to function as the speaker.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. US 2003/0087665 by Tokkonen as applied to claim 8 above, and further in view of U.S. Patent Application Publication No. US2002/0118798 by Langhart et al.

Regarding claim 9, the mobile apparatus of claim 8 mentioned above, wherein Tokkonen further discloses the desired operation mode, inherently, includes a recording mode or reminder function mode (page 2, column 1, section 0014, lines 1-4) and a calling mode (page 1, column 2, section 0011, lines 6-9); and wherein: the mobile apparatus inherently functions as a telephone when the calling mode is selected (page 2, column 1, section 0014, lines 31-33) and the mobile apparatus functions as an audio recorder when the recording mode is selected (page 2, column 1, section 0014, lines 20-23).

Tokkonen fails to teach a desired operation mode that includes a recording/calling mode wherein the mobile apparatus functions as a conversation recorder when the recording/calling mode is selected.

Langhart et al disclose a method for recording telephone conversations (see Abstract), the method comprising: providing the mobile apparatus, wherein the mobile device includes: a wireless telephone (Figure 1, 105; page 2, column 1, section 0019, lines 13-14), inherently, having a microphone and a speaker; and an audio recording mechanism integrated within the wireless telephone (page 2, column 2, section 0019, lines 9-11; using the audio recording mechanism to record an audio (page 2, column 2, section 0020, lines); and playing back the recorded audio input from the audio recording mechanism of the wireless telephone (page 2, column 2, section 0021, lines 11-23). Langhart et al further disclose a desired operation mode that includes a recording/calling mode (page 2, column 2, section 0020, lines 5-12), wherein the

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mobile apparatus functions as a conversation recorder when the recording/calling mode is selected (page 2, column 2, section 0020, lines 16-19; page 2, column 2, section 0021, lines 1-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Tokkonen to include a recording/calling mode as taught by Langhart et al in order for a conversation to be recorded. One of ordinary skill in the art would have been lead to make such a modification since a user would activate the recording/calling mode in order to record a conversation between parties on the telephone call.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. US 2003/0054802 by Xie teaches a mobile set integrating a memory efficient data storage system for the real time recording of voice conversations and data transmission

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
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Or faxed to:

(703) 872-9314 (for formal communications intended for entry)


Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

lh 
November 27, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

